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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/550,187	09/21/2005	Javier Sanchez	W1878.0222	5315

32172 7590 02/01/2008  
DICKSTEIN SHAPIRO LLP  
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NEW YORK, NY 10036-2714

EXAMINER
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KAO, WEI PO ERIC

ART UNIT	PAPER NUMBER
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2616

MAIL DATE	DELIVERY MODE
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02/01/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/550,187	SANCHEZ, JAVIER	
	<b>Examiner</b>	<b>Art Unit</b>	
	Wei-po Kao	2616	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 September 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 September 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Priority*

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### *Abstract*

2. The abstract of the disclosure is objected to because of the following informality:

The abstract contains typographical mistakes, namely T?offset#191.

Correction is required. See MPEP § 608.01(b).

### *Drawings*

3. The drawings are objected to because the rectangular box(s), figure 1 elements 14, 16 and 18, shown in the drawings should be provided with descriptive text labels; "GMS" in figure 1

elements 6 and 8 should be replaced with "GSM". Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

4. In addition to Replacement Sheets containing the corrected drawing figure(s), applicant is required to submit a marked-up copy of each Replacement Sheet including annotations indicating the changes made to the previous version. The marked-up copy must be clearly labeled as "Annotated Sheet" and must be presented in the amendment or remarks section that explains the change(s) to the drawings. See 37 CFR 1.121(d)(1). Failure to timely submit the corrected drawing and marked-up copy will result in the abandonment of the application.

***Claim Objections***

5. Claims 1, 6 and 7 are objected to under 37 CFR 1.75 because of the following informalities:

The claimed term, “the first radio technique,” of claim 1 line 7 seems to refer the first of the two distinct radio access techniques. It is suggested to change to “the first access radio technique.”

The claimed term, “the first radio technique,” of claim 6 line 7 seems to refer the first of the two distinct radio access techniques. It is suggested to change to “the first access radio technique.”

The phrase “capable to” recited in claim 1 line 2, claim 6 line 2 is not positively recited claim language. Therefore, the limitations after the phrase are not considered the claim limitation. It is suggested that the applicant remove the phrase. However, the reference cited teaches the subject matter following the phrase.

Appropriate correction is required.

***Claim Rejection - 35 USC § 103***

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over the background of Sanchez, U.S. Publication No 20060182147 (admitted prior art) in view of Leprieur et al, U.S. Publication No 20030003951.

Regarding Claim 1, the admitted prior art teaches that **a method for time-synchronization of at least two radio access modules of a multimode communication terminal capable to function according to at least two distinct radio access technique in a cellular telecommunication network in which one of the radio access modules is active in a current cell and the other radio access module is in a passive state in the current cell (see [0003] [0009]), the method comprising steps of: (a) measuring for each of cells adjacent to the current cell a time offset  $T_{\text{offset}}$  between start of a specific frame of the first radio technique and start of a specific frame of the second radio access technique (see [0009] [0020] [0021]).** However, the admitted prior art does not teach that **the method, wherein (b) using the time offset  $T_{\text{offset}}$  measured in step (a) for synchronizing the passive radio access module with the active radio access**

**module.** Leprieur et al from the same field of endeavor teach that **the method, wherein (b) using the time offset  $T_{\text{offset}}$  measured in step (a) for synchronizing the passive radio access module with the active radio access module** (see Abstract, [0016] [0032] [0045]). At the time of the invention, it would have been obvious to a person ordinary skill in the art to synchronize the two radio access technique using the time offset between the two. The motivation would have been that it is desired to guarantee smooth switching between two different radio access technologies e.g. [0045] line 5-10.

Regarding Claim 2, the admitted prior art further teaches that **the method further comprising a step of activating the passive radio module from the active radio access module** (see [0005] Line 4-5, [0009] Line 10-12 i.e. switching from a network to the other causing a passive module to become active).

Regarding Claims 3 and 10, the admitted prior art further teaches that **the method, comprising a step of updating a value of the offset  $T_{\text{offset}}$  on each change of the current cell and for each neighboring cell associated with the radio access technique of the passive module** (see [0005] [0009] [0020] i.e. the UMTS/GSM switching technique and  $T_{\text{offset}}$ /OTD calculation according to 3GPP standard must be able to perform repeatedly since it is an cellular communication environment and the states of current cell and its neighboring cells are constantly changing).



Regarding Claim 4, 11, 12 and 13, the admitted prior art further teaches that **the method, wherein the mobile terminal is a UMTS/GSM dual-mode terminal and wherein the predefined duration T<sub>offset</sub> is a time difference observed on GSM defined in standard 3GPP TS 25.215 (see [0020]).**

Regarding Claim 5, the admitted prior art further teaches that **the method, wherein the activation of the passive access module is made immediately before the measurements on cells adjacent to the current cell** (see [0003] [0005] [0009] i.e. consider the following scenario: when a dual-mode terminal is in a UMTS cell, it first measures the T<sub>offset</sub>; when it moves to a neighboring GSM cell, it has to secondly active the passive module; when it is in the GSM cell, it then again thirdly measures T<sub>offset</sub>; the steps then repeats; therefore, when the dual-mode terminal repeats second and third steps, the passive module is activated immediately before the measuring the T<sub>offset</sub> again and again).

Regarding Claim 6, it is a device claim corresponding to the method claim 1, and therefore rejected under the same reason set forth in the same section of claim 1 in this paragraph.

Regarding Claim 7, the admitted prior art teaches that **a multimode mobile terminal comprising: a radio access module dedicated to each operating mode** (see [0003] [0009]). However, the admitted prior art does not teach that **a clock generator associated with each**

radio access module; and a unit for calculating a time offset  $T_{\text{offset}}$  between start of a specific frame of a first operating mode and start of a specific frame of a second operating mode in a cellular telecommunication network, wherein the mobile terminal comprises a central interface capable to generate a clock signal of a passive radio access module shifted with respect to a clock signal of an active radio access module concerning the duration  $T_{\text{offset}}$ . Leprieur et al from the same field of endeavor teach that a clock generator associated with each radio access module (see [0013] [0022]); and a unit for calculating a time offset  $T_{\text{offset}}$  between start of a specific frame of a first operating mode and start of a specific frame of a second operating mode in a cellular telecommunication network (see [0018-0023] [0025] line 1-10), wherein the mobile terminal comprises a central interface capable to generate a clock signal of a passive radio access module shifted with respect to a clock signal of an active radio access module concerning the duration  $T_{\text{offset}}$  (see [0025] e.g. line 10-12). At the time of the invention, it would have been obvious to a person ordinary skill in the art to include a clock for each radio access module, a unit for calculating  $T_{\text{offset}}$  and a central interface for generating clock signals in a multi-mode mobile terminal. The rationale would have been that with commonly available yet necessary (i.e. a clock is a must to measure time) components, the multi-mode terminal can be cost effective and adapted by general public, thus applied to different network technologies accepted by different nations.

Regarding Claim 8, the admitted prior art further teaches that **the mobile terminal, wherein the central interface comprises a module for generating an order for activating the passive**

**radio access module** (see [0005] Line 4-5, [0009] Line 10-12 i.e. switching from a network to the other causing a passive module to become active).

Regarding Claims 9 and 14, the admitted prior art further teaches that **the mobile terminal, wherein the mobile terminal supports a UMTS network and a GSM network** (see [0020]).

### *Conclusion*

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Referring to the PTO Form 892, references are cited to show similar dual mode UMTS/GSM method and system.

11. Examiner's Note: Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wei-po Kao whose telephone number is (571)270-3128. The examiner can normally be reached on Monday through Friday, 8:30AM to 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky Ngo can be reached on (571)272-3139. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

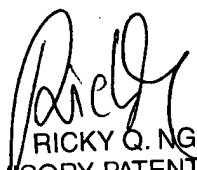
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W.K.



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SUPERVISORY PATENT EXAMINER